

Application No. 09/927,485

REMARKS

This Amendment and Response is intended to fully respond to the Office Action dated December 16, 2003. In that Office Action, claims 2-7 and 9-20 were examined in the Office Action; and all were rejected under 35 U.S.C. 103(a) as being unpatentable over Kassab (USPN 6,258,200) in view of Langen (USPN 5,290,067). No claims have been amended, cancelled, or added. Claims 2-7 and 9-20 are now pending. Reexamination and reconsideration of the rejections are respectfully requested in light of these remarks.

Claim Rejections – 35 U.S.C. § 103

Claims 2-7 and 9-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kassab (USPN 6,258,200) in view of Langen (USPN 5,290,067). Applicant respectfully traverses Examiner's rejection. Applicant respectfully asserts that Kassab and Langen fail to disclose or suggest all of the limitations of the pending claims, either alone or in combination and thus the Examiner has failed to establish a prima facie case of obviousness. That is, a prima facie case of obviousness can only be established when all of the following requirements are met: (1) there must be some suggestion or motivation in the references themselves to combine the references; (2) there must be a reasonable expectation of success; and (3) the reference or combination of references must teach or suggest all the claim limitations. See MPEP §§ 706.02(j) and 2143. Specifically, Applicant asserts that the references do not disclose a substantially transparent information sheet with printed MSRP information on the sheet, wherein the sheet exhibits static-cling properties.

The first component of the claimed invention is a *single information sheet* with static-cling properties, whereas Kassab discloses in Figs. 3-8 a static-cling *sticker assembly*, comprising an adhesive sticker and static-cling film (Col. 6, lines 28-31). The assembly in Kassab uses a *separate* static-cling sheet and a sticker containing an indicia-bearing substrate (col. 5, lines 63-65). The claimed invention greatly improves upon Kassab by replacing the two-part assembly with a single-part, static-cling label. Like Kassab, Langen also teaches a two-component product, i.e. a label that has added elements, namely adhesive strips. Therefore, the references do not disclose, either explicitly or inherently, the integral label having cling-type properties as defined in claims 2, 11 and 16.

Secondly, the references do not disclose a *substantially transparent* information sheet as

Application No. 09/927,485

in the claimed invention. While the affixing device in Kassab (the static-cling film) may be transparent, Kassab clearly states that the resulting static-cling sticker assembly is not substantially transparent: "In addition, having too many city stickers mounted on the windshield creates blind spots thereby reducing a driver's vision through the windshield." Kassab, Col. 8, lines 1-4 (internal references omitted). Furthermore, the static-cling film is not analogous to an information sheet as it has no information on it – it is blank – until a sticker or artwork is affixed to it (rendering the combination no longer substantially transparent). As a result, Kassab clearly does not show the substantially transparent information sheet element of claims 2, 11 and 16.

Langen is directed to an MSRP label that has "repositional adhesive strips." The purpose of these strips is to provide a sticker that can be easily removed and repositioned on a window without leaving a residue. Throughout Langen, bond paper (which is opaque) is the material of choice for constructing the sticker. No mention is made of this sticker not impairing the vision of a driver of the motor vehicle. Although Langen briefly mentions that the label may be made from transparent plastic (Col. 5, lines 66-68 and Col. 6, lines 1-2), there is simply no discussion or teaching of the benefits of such a transparent label. The claimed invention improves upon the driver's visibility over Langen. The Langen label has adhesive strips that interfere with the driver's vision, even if the label itself is transparent. Also, any space between the window and the non-adhesive sections of a transparent material will interfere with visibility as well (such gaps are prone to light refraction and reflection). Langen, therefore, does not show the substantially transparent information sheet element of claims 2, 11 and 16.

In addition to failing to teach or suggest the integral transparent information sheet having both the MSRP information and the static-cling properties of the claimed invention, the references do not provide a teaching or suggestion to combine the references such that a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been established. There is absolutely no suggestion in Langen to modify its teachings to use something other than adhesive strips, let alone use the static-cling sheet from Kassab, as a means for adhering the label to the window. More importantly, since Langen provides an easily removable label, there is no reason to combine Langen with Kassab. Kassab transforms labels that are not easily removable and makes them so. However, there is no reason to use Kassab for a label that is already easily removable such as Langen. Accordingly, there is no suggestion to combine the references.

Application No. 09/927,485

The Examiner focuses on the MSRP indicia from Langen and argues that to one having ordinary skill in the art at the time the invention was made it would have been obvious to modify Kassab's label with any type of indicia as taught by Langen. This cannot be true given the teachings of Langen. Clearly Langen provides a system for easily removing a MSRP label. Thus, since Langen teaches a label that can be removed and repositioned based on repositioning strips, there is no motivation to combine these references.

Since the combination of Langen with Kassab does not disclose the integral transparent information sheet having both the MSRP information and the static-cling properties, the references do not render claims 2-7 and 9-20 obvious as a matter of law. Moreover, there is absolutely no expectation of success if you did combine Langen and Kassab. That is, the combination is a two-part label, that is not substantially transparent. Clearly, one could not expect that this combination would result in a substantially clear label as defined by the present claims.

With regard to claims 11 and 16, neither Langen nor Kassab discloses or teaches a removable opaque sheet having static-cling properties that may be affixed to a substantially transparent information sheet to provide contrast allowing for easy reading of the MSRP information on the transparent information sheet. Langen makes no mention whatsoever of an opaque sheet nor of anything with static-cling properties – that reference is easily disposed of in reference to claims 11 and 16. The Examiner instead discusses Kassab. The windshield sticker (30) described in Kassab is not an opaque base sheet as argued by the Examiner, but is instead a sticker containing the information that is to be displayed (col. 6, lines 2-4). The Kassab sticker (30) does not have static cling properties, but instead uses an adhesive layer to *fixedly* (i.e. *not* removably) attach the sticker to a receiving surface (col. 6, lines 8-21). Kassab discloses that the sticker has a protective paper layer covering the adhesive of the sticker (col. 6, lines 8-10). This layer cannot be classified as an 'opaque base sheet' because if the layer is left on the sticker, the sticker cannot be affixed to the receiving surface, and the static-cling sticker assembly cannot be created. Furthermore, nowhere in Kassab is there any reference to this protective layer having static cling properties. Once the protective layer in Kassab is removed from the sticker it is discarded, never to be affixed to the information sheet again. Therefore, Kassab does not teach a substantially opaque base sheet having static-cling properties permitting the base sheet to be

Application No. 09/927,485

removably affixed to the information sheet, as does the claimed invention. Since the references clearly do not show this element of claims 11 and 16, they cannot form the basis of a 35 U.S.C. § 103(a) rejection of it.

With respect to claims 15 and 20, the Examiner cites *In re Gulack* (217 USPQ 401, (CAFC 1983)) as support for stating that the MSRP information does not patentably distinguish the present invention from Kassab. The Applicant respectfully traverses this conclusion, because *Gulack*, as it relates to the present invention supports the finding that the MSRP information alone patentably distinguishes the present invention from Kassab. *Gulack* states that "[w]here the printed subject matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art." *Gulack*, 217 USPQ 401 at 403. The test in *Gulack* for a functional relationship is "whether there exists any new and unobvious functional relationship between the printed matter and the substrate." *Id.* The court found in *Gulack* that random items of text on a hatband were not functionally related but that an infinite number series on a ring was functionally related as the ring, also, is infinite.

In the present invention, there is a functional relationship between the MSRP information and the sheet. The MSRP information must be on the car window, but its contrasting background does not, and the transparent sheet allows it to be there safely. In fact, the MSRP information in this case could be considered the substrate as it is the structural element that is required by law to be on the window. The present invention is directed to displaying that element as safely as possible. Therefore, *Gulack* requires the finding that MSRP information does render the present invention patentably distinct from Kassab, wherein the contents of the sticker in Kassab are irrelevant to the affixing device.

In response to this argument, the Examiner apparently concedes that MSRP information is functionally related to the sheet and instead highlights a subcomponent of the MSRP information: "information related to country of origin of manufacture of parts of the vehicle." The Examiner then argues that the question is whether the highlighted subcomponent is functionally related to the sheet, instead of whether the whole MSRP information is functionally related to the sheet. However, as the highlighted information is simply a subcomponent of the total MSRP information, this argument utterly fails. Therefore pending claims 15 and 20 are patentably distinguishable from Kassab because of this functional relationship.

Application No. 09/927,485

As claims 2, 11 and 16 are now allowable for the reasons given above, so too are all the claims dependent therefrom. Thus, Applicant respectfully requests that the Examiner withdraw his rejections and find the pending claims allowable. Reconsideration of the § 103 rejection is hereby requested.

Conclusion

As originally filed, the present application included 43 claims, 6 of which were independent. As the result of a restriction requirement, Applicant elected Claims 1-20 for prosecution, 3 of which are independent. As amended, the present application now includes 18 claims, 3 of which are independent. It is believed no further fees are due with respect to the claims. That said however, Applicant is providing, herewith, the fee for a three-month extension of time. It is believed that no additional fees are due at this time. If the Examiner determines that other fees are due with respect to this application, the Examiner is authorized to charge these fees to deposit account number 13-2725. It is believed that the application is now in condition for allowance, and such action is respectfully requested. Should any additional issues need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Respectfully submitted,

Dated: 6/16/04



Timothy B. Scull
Timothy B. Scull
Attorney Reg. No. 42,137
Merchant & Gould P.C.
Box 2903
Minneapolis, MN 55402-2215
303-357-1648